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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/920,961 | 08/03/2001 | Edwin Lyda | 42159-023 | 5875 |

30568 7590 08/03/2007

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|---|---|
| SHELEHEDA, JAMES R | |
| **ART UNIT** | **PAPER NUMBER** |
| 2623 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/03/2007 | PAPER |

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 09/920,961
Filing Date: August 03, 2001
Appellant(s): LYDA, EDWIN

Mary J. Gaskin
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 04/02/07 appealing from the Office action mailed 11/02/06.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Withdrawn Rejections

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

The rejection of claims 1-2, 13-15, 17, 20-21 and 23 under 35 U.S.C. 112 first paragraph.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

| | | |
|---|---|---|
| WO 99/04568 A1 | Ferris et al. | 01/1999 |
| 6,704,317 | Dobson | 03-2004 |
| 5,721,584 | Yoshinobu et al. | 02-1998 |
| 5,303,042 | Lewis et al. | 04-1994 |
| 6,466,203 | Van Ee | 10-2002 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2, 13-15, 17, and 20-21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferris et al. (WO 99/04568).

Claim 1, Ferris discloses an electronic response device (Fig, 3, el. 417; Fig. 4-6) other than a personal computer, the response device configured to allow user to send

data over a standard communication system (see Fig. 3), in response to a program received apart from the responsive device (the remote control device is used to respond to programming/"television programming show", i.e. tool show with option to buy a product, received apart from the response device, for example Ferris' s Fig. 4; page 23) , the response device comprising:

a user input mechanism for entry of user input and responses (Fig. 5, el. 622 and Fig. 2L, page 27, lines 13-19), the mechanism operating without receiving signals eliciting a response by the user (broadly reads on Ferris' s response device able to receive display data (signals) that able user to elicit or Not to elicit a response by the user, for example, the user is able to view the received display information and the user either to choose or NOT to choose to response to received display data (signals) by disabling or by NOT disabling the notification feature (page 20, lines 10-14) and/or locking the device (page 22, lines 20-24), as desired. As such, Ferris 's device clearly encompasses the amended claimed limitation because in one embodiment in which the user disables the notification features and locks the device, the user is NOT able to response to the receiving display data because the receiving display data is not able to elicit a response by the user, as such the receiving display data is NOT a receiving signals eliciting a response by the user. Therefore, Ferris' s remote control operates without receiving signals eliciting a response by the user).

means for requiring (input controller 611) the user's input of a program identifier code for the program received apart from the responsive device (the user able to interact with program-associated material as shown in Fig. 2A wherein the user must

input "product/vendor code" in order to purchase a product, see Fig. 2L, page 27, lines 13-19; therefore, Ferris clearly respond to a program received apart from the response device);

means for providing a user identifier code, the means selected from the group consisting of having the identifier code associated with the response device and having the user input the user identifier code (reads on Ferris' s HUUID represents User Identification associated with the remote control device; see page 25; 4th paragraph; Fig. 2K).

a central processing unit (microprocessor 607) for correlating the responses the user has entered into the user input mechanism to the program identifier code and for processing the program identifier code, the user identifier code, and responses the user has entered into the user input mechanism (reads on: by responding to the "product/vendor code" input through the handheld device on the basis of the information inputted by the user, the inputted "product/vendor code" is transmitted back to the central control station along with HUUID (page 13, 3rd paragraph). In doing so, the inputted "product/vendor code" constitutes an input from the user of a program identifier code (PADUID) for the particular programming event (displays PAD) in which the user is responding along with the user identifier code associated with the remote device (HUUID); see page 13, 3rd paragraph. )

a power source (inherently must have); and

a transmitter connected to the CPU (603 and 614).

Claim 2, Ferris further discloses wherein the input mechanism is selected from the group consisting of a keypad and voice recognition apparatus (Fig. 5, el. 622; page 15, 5th paragraph);

the transmitter comprises a two-way paging device (Fig. 5, el. 603; page 18; 2nd paragraph); and the communication system comprises a two-way paging system (page 12; 3rd paragraph).

Claim 13, method claim is analyzed with respect to apparatus claim 1, Ferris further discloses a method for receiving and processing responses to a program selected from the group consisting of radio broadcast, a television broadcast...(page 10, 8th paragraph) and collecting the response data at a central location; correlating the program identifier code to the responses; processing the response date (page 15, 1st paragraph; page 24, 1st-3rd paragraph).

Claim 14, Ferris further discloses sending the processed data to a presenter of the program for viewing (page 15, 1st paragraph and page 24, 3rd paragraph).

Claim 15, Ferris further discloses having the presenter of the program respond to the audience center (interactive story line; page 9, 4th paragraph).

Claim 17 is analyzed with respect to claim 2.

Claim 20, Ferris discloses a system for receiving and processing responses to a program selected from the group consisting of radio broadcast, a television broadcast...(page 10, 8th paragraph) comprising;

Providing a program identifier (PADUID) for a program being presented (page 13, 3rd paragraph);

Providing a user input device other than a personal computer (Fig, 3, el. 417; Fig. 4-6), the device generating without receiving signals eliciting a response by a user (broadly reads on Ferris' s response device able to receive display data (signals) that able user to elicit or Not to elicit a response by the user, for example, the user is able to view the received display information and the user either to choose or NOT to choose to response to received display data (signals) by disabling or by NOT disabling the notification feature (page 20, lines 10-14) and/or locking the device (page 22, lines 20-24), as desired. As such, Ferris 's device clearly encompasses the amended claimed limitation because in one embodiment in which the user disables the notification features and locks the device, the user is NOT able to response to the receiving display data because the receiving display data is not able to elicit a response by the user, as such the receiving display data is NOT a receiving signals eliciting a response by a user. Therefore, Ferris' s remote control operates without receiving signals eliciting a response by a user).

Having an audience member input the a program identifier code (PADUID) into the user input device (Ferris' s PAD constitutes an offering/object displayable to user and requires user to express interaction with the PAD through the handheld device on the

basis of the information so displayed. By interacting with the presented PAD, the selected PAD is transmitted back to the central control station along with HUUID and PADUID (page 13, 3rd paragraph). In doing so, the selected PAD includes HUUID and PADUID constitutes an input from the user of a program identifier code (PADUID) for the particular programming event (displays PAD) in which the user is responding along with the user identifier code associated with the remote device (HUUID); see page 13, 3rd paragraph);

Having an audience member input response into the user input device (Fig. 5, el. 622; page 15, 1st and 5th paragraph);

Transmitting the program identifier and the response data associated with a user identifier over a standard communication system (page 12; 3rd paragraph);

Collecting, correlating and processing the program identifier and the responses (page 15, 1st paragraph; page 24, 1st-3rd paragraph);

Routing the responses to a program presenter (interactive story line; page 9, 4th paragraph).

Claim 21, Ferris further discloses having the presenter respond to the audience member (interactive story line; page 9, 4th paragraph).

Claim 23 is analyzed with respect to claim 2.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferris et al. (WO 99/04568) in view of Dobson (US 6704317).

Claim 3, Ferris further discloses wherein the input mechanism is selected from the group consisting of a keypad and voice recognition apparatus (Fig. 5, el. 622; page 15, 5th paragraph);

Ferris does not clearly disclose the transmitter is configured to send data burst over standard telephone lines; and the communicating system comprises a plain old telephone system.

Dobson discloses the transmitter is configured to send data burst over standard telephone lines; and the communicating system comprises a plain old telephone system (Col. 10, lines 25-33); Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ferris to have Ferris' s transmitter configured to send data burst over standard telephone lines; and the communicating system comprises a plain old telephone system, as taught by Dobson, so that any communication device on the network may transmit data to the public network by way of multi-point transceiver and the POTS modem transceiver (Col. 4, lines 1-6).

Claims 4, 5, 6, 18 and 24 are rejected under 35 U.S.C. 103(a) as being obvious over Ferris et al. (WO 99/04568).

Claim 4, Ferris discloses wherein the input mechanism is selected from the group consisting of a keypad and voice recognition apparatus (Fig. 5, el. 622; page 15, 5th paragraph); Ferris further discloses the outbound PAD could be transmitted using 'data-

hiding' technology associated with a response to the program over any types of communication network (pages 12-14).

Ferris does not disclose the transmitter is configured to call telephone numbers each of the telephones numbers having been associated with a particular response to the program; and the communication system comprises a plain old telephone system.

Official Notice is taken that having a remote control with integrated modem with associated call number for communication purpose using of a plain old telephone system is notoriously well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ferris to have an integrated modem built in the handheld device so to provide to user an alternative way to communicate with the service provider beside of the two-way paging network.

Claims 5 and 6 Ferris further disclose wherein the input mechanism is selected from the group consisting of keypad and voice recognition apparatus (Fig. 5, el. 622; page 15, 5th paragraph) and the request might be sent over the Internet (see page 14; 4th/last paragraph).

Ferris does not disclose the transmitter comprises a wireless Internet protocol device, and the communication system comprises Internet protocol systems; wherein the Internet protocol system further communicates with a telecommunication system.

Official Notice is taken that having a remote control with integrated wireless modem for communication purpose through Internet in which the Internet network is in

communication with a telecommunication network is notoriously well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ferris to have an integrated wireless modem built in the handheld device so to provide to user an alternative way to communicate with the service provider through Internet network beside of the two-way paging network.

Claim 18 is analyzed with respect to claim 4.

Claim 24 is analyzed with respect to claim 4.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferris et al. (WO 99/04568) in view of Yoshinobu et al. (US 5721584).

Claim 7, Ferris shows activities (alert with flashing led 10) during connectivity (page 22, 6$^{th}$ paragraph) during communication.

Ferris does not clearly disclose an indicator for indicating the connection status of the electronic response device to a communication system;

Yoshinobu discloses an indicator for indicating the connection status of the electronic response device to a communication system (Col. 12, lines 22-30 and col. 18, lines 1-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ferris with Yoshinobu so to provide to user a way to detect the condition (Connect or Not connect) of the communication process between two communication devices.

Claims 19 and 25 are rejected under 35 U.S.C. 103(a) as unpatentable over Ferris et al. in view of Lewis et al (US 5303042).

Claims 19 and 25, Ferris discloses the users log on the keypad device (page 25, 3rd and 4th paragraph) and **see page 8, 3rd paragraph** in which Ferris suggests that the system has some type of logging the interaction in a user database.

Ferris does not clearly disclose the audience member log into a remote computer system before inputting data into the user input device;

Lewis discloses the audience member log into a remote computer system before inputting data into the user input device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ferris with Lewis so that the remote computer able to track all viewer currently log on the system (Col. 8, lines 25-45).

**(10) Response to Argument**

Appellant's arguments on pages 5-7, in regards to the rejections under 35 U.S.C. 112 first paragraph, are moot as this rejection has been withdrawn.

Rejection under 35 U.S.C. 102(b) over Ferris

On pages 7-10, of appellant's brief, appellant argues that the Ferris system must receive display data before a user may enter a selection and that in all cases the user is

limited to "responding" to the data on the display, which fails to meet the current claim limitations.

In response, it is noted that the actual claim language in regards to a user responding is "a user input mechanism for entry of user input and responses, the mechanism operating without receiving signals eliciting a response by the user."

More specifically, it is noted that the claim limitation requires that the ***input mechanism*** operate without receiving signals eliciting a response by the user. In the disclosed invention the *input mechanism* merely comprises a key-pad for inputting data (as seen on page 8, lines 1-4 of appellant's specification and further in claims 2-5). Various keys on the keypad are pressed for inputting user selections. The basic functionality of a keypad is for a one-way input of information, as signals are not transmitted back to a particular button on the device, i.e. a remote control generates an output signal upon user depression of the "3" key, the remote control will not transmit a signal to the "3" key. Thus, Ferris clearly meets the current claims, as Ferris's keypad, operating in the same manner as appellant's own disclosed input, operates without receiving signals eliciting a response by the user. The ***keypad*** itself will not receive any signals whatsoever except those originating from the user. The very basis of appellant's argument is flawed, as none of the claims require a *response* device to operate without receiving signals eliciting a response by the user.

Further, in response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which

appellant relies (i.e., the ***response device*** operating without receiving signals eliciting a response by the user, not requiring an "on board" memory and not requiring a sophisticated means for synchronizing the data) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 11, of appellant's brief, appellant argues that in the Ferris system a user will respond to PAD items corresponding to downloaded offers and that the user is not responding to a program received apart from the device.

In response, Ferris specifically discloses wherein an offer is presented to a user *synchronized* with the corresponding television broadcast (see page 23, lines 3-11 and page 24, lines 7-14). Thus, the PAD is presented directly in response to the corresponding television program. As the user is enabled to purchase the indicated item, *in response to the presentation of the television broadcast*, Ferris clearly meets the current claim limitations.

In response to appellant's arguments on pages 11-12, regarding the operation of the mechanism without receiving signals eliciting a response by the user, please see above as to appellant's misunderstanding regarding the actual claim limitations. The claims merely require that the key-pad operate without receiving signals eliciting a response by the user, not the response device.

In response to appellant's arguments on page 12, regarding the inputting of a program identifier code, it is noted that Ferris discloses wherein the user will specifically enter an identification of the PAD, related to the program, desired by the user (see page 23, lines 19-29 and page 27, lines 10-20). This clearly meets the claim limitation of a "program identifier code" as it is identifying the particular PAD desired. Further, as the PAD is specifically synchronized with or "for" a specific program, the identifier is clearly "for the program received apart from the response device".

In response to appellant's arguments on page 13, regarding the correlation of the user responses, Ferris specifically discloses wherein the user interaction data is "correlated" for transmission (page 13, lines 18-27). In this case, the device is taking the disparate pieces of information, such as the HUUID and the PADUID and any other user interactions, and then linking them for transmission. As the user interaction, such as a purchase request, requires several different pieces of data, such as the particular PADUID indicating the item and the HUUID indicating the particular user, the combining of this data for transmission *together* clearly meets the current broad limitation of correlating. Further, as the microprocessor in Ferris is clearly disclosed as controlling operations of the system, including *causing interaction data to be transmitted* (page 16, lines 14-19), this clearly meets the claim limitation of wherein the CPU is performing the correlating.

In response to appellant's arguments on pages 13-14, directed to claims 13, 14 and 17, see above, in regards to claims 1 and 2, regarding the inputting and correlating of the user and program information and further in regards to a user "responding" to a program.

On page 14, appellant argues that Ferris fails to disclose "having the presenter of the program respond to the audience member".

In response, it is noted that while the claim requires the presenter to respond to the audience member, there is no specific requirement for any particular *type* of response. Ferris discloses wherein the user may attempt to purchase an advertised product from the presenter of the ad (page 24, lines 7-14) and would then be informed of the status of their purchase (page 14, lines 17-25 and page 27, lines 1-8). Additionally, a user may request that the sponsor provide further information (page 14, lines 29-30). Also, broadcasters may respond to user input by adjusting the future broadcast content itself (column 15, lines 1-4). Thus, Ferris clearly meets the broad limitation of "having the presenter of the program respond to the audience member".

In response to appellant's arguments on page 14-15, directed towards claims 20 and 23, see above as it has already been shown that that Ferris discloses wherein the user will specifically enter an identification of the PAD, related to the program, desired by the user (see page 23, lines 19-29 and page 27, lines 10-20). This clearly meets the

claim limitation of a "program identifier code" as it is identifying the particular PAD desired.

In response to appellant's arguments on pages 15-16, regarding the operation of the mechanism without receiving signals eliciting a response by the user, please see above as to appellant's misunderstanding regarding the actual claim limitations. The claims merely require that the key-pad operate without receiving signals eliciting a response by the user, not the response device.

In response to appellant's arguments on page 16, see above, in regards to regarding the correlating of the user and program information.

In response to appellant's arguments on page 16, in regards to "having the presenter response to the audience member", see above wherein it has already been shown that Ferris discloses wherein the user may attempt to purchase an advertised product from the presenter of the ad (page 24, lines 7-14) and would then be informed of the status of their purchase (page 14, lines 17-25 and page 27, lines 1-8). Additionally; a user may request that the sponsor provide further information (page 14, lines 29-30). Also, broadcasters may respond to user input by adjusting the future broadcast content itself (column 15, lines 1-4). Thus, Ferris clearly meets the broad limitation of "having the presenter of the program respond to the audience member".

Rejection under 35 U.S.C. 103(a) over Ferris and Dobson

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ferris discloses utilizing a two-way transceiver for data transmissions (see Fig. 5 and page 18, lines 7-15). Ferris fails to specifically disclose transmitting burst communications over plain old telephone wires. Dobson discloses utilizing a POTS modem for burst communications over telephone wires (column 10, lines 1-33). As this provides the benefit of allowing the communication system to utilize typically available telephone wires for transmission, appellant's arguments are not convincing.

Rejections of claims 4, 5, 6, 18 and 24

In response to appellant's arguments on pages 17-19, it is noted that Ferris specifically discloses wherein the system will contact different locations associated a particular response from the user (such as a request to purchase a product is transmitted to the sponsoring party; page 14, lines 17-30). Ferris simply fails to disclose utilizing different telephone numbers to contact the different parties. Ferris was then

modified to provide for use of the plain old telephone system, with telephone number dialing to connect to different locations, to provide for communications.

Thus, Ferris would clearly meet the claim limitations as contacting *different* parties based upon the user response, when utilizing telephone numbers, would clearly require the basic usage of *different* telephone numbers as is well understood in the art.

Rejection of claim 7

In response to appellant's arguments to dependent claim 7, please see above regarding the rejection of claim 1.

Rejection of claims 19 and 25 under 35 U.S.C. 103(a) over Ferris and Lewis

On pages 19-20, appellant argues that Ferris fails to disclose "having the audience member log into a remote computer system before inputting data into the device."

In response, as indicated in the rejection, Ferris discloses wherein the audience member will log into a system (i.e. the handheld device) before inputting data into the device (at page 25, 3rd and 4th paragraphs). Ferris further discloses logging user interactions (tracking user actions) within a user database (page 8, 3rd paragraph).

Ferris simply fails to disclose having the audience member will log into a *remote* computer system. Lewis discloses a system wherein users login to a remote computer to allow tracking of user operations. Thus the combination of Ferris and Lewis meets the current claim limitations.

Further, in response to appellant's argument that this would change the principle of operation of Ferris, it is noted that Ferris includes repeated usage of remote systems and computers in communication with the remote control (as illustrated in Fig. 3, page 13, lines 18-27 and page 14, lines 17-31). Therefore, appellant's argument that the use of a *remote* computer for tracking user information, as indicated in the combination with Lewis, is not convincing.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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